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EXAMINER
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ART UNIT	PAPER NUMBER
2121	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/973,501	KERVEN ET AL
	Examiner	Art Unit	
	Meltin Bell	2121	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _01 June 2004_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-27_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-27_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _01 June 2004_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

    1. ☐ Certified copies of the priority documents have been received.

    2. ☐ Certified copies of the priority documents have been received in Application No. _____.

    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892) ⊛

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to application **09/973,501** filed 10/08/01 as well as the

Substitute Oath/Declaration, Specification Paragraph Replacements, Drawing

Corrections and Amendment A filed 6/1/04. Claims 1-27 filed by the applicant have

been entered and examined. An action on the merits of claims 1-27 appears below.

Priority

Applicant's claim for domestic priority against application number 60/238,566

filed **10/6/00** under 35 U.S.C. 119(e) is acknowledged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the Office presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were

made absent any evidence to the contrary. Applicant is advised of the obligation under

37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the Office to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 1-4 and 7-27 are rejected under 35 U.S.C. 103(a) as being unpatentable

over *Jain et al* U.S. Patent Number 5,983,237 (November 9, 1999) in view of *Rivette et*

al U.S. Patent Number 5,754,840 (May 19, 1998) and in further view of *Doyle* U.S.

Patent Number 6,009,455 (December 28, 1999).

Regarding claim 1:

Jain et al teaches,

- (a) a data store comprising one or more storage elements (Fig. 1, item 112)

- (b) one or more processors in communication with each other and the data store (Fig.

1, item 102), the one or more processors for:

- (i) receiving the query comprising one or more query terms (Figs. 2, 3, 8)

- (ii) creating a search phrase by (Figs. 4, 8-10C; column 1, lines 31-42, "An important

class ... and so on")

- (1) initializing the search phrase to include the query terms (Fig. 9, items 370, 372)

- (2) identifying variations for any of the query terms, wherein the identified variations

are of a type selected from the group consisting of homonyms, translations and

common misspellings (Fig. 10A, items 406, 408, 432, 434)

- (3) if any variations were identified, adding the identified variations to the initialized

search phrase (Fig. 10A, items 410, 436)

- (iii) generating a search result set by (Figs. 3-4, 8, 10A-C, 12-13B):

- (1) conducting one or more searches in one or more accessible information storage

systems based upon the created search phrase (Fig. 3)

- (2) accumulating results from each of the conducted searches in the search result set

(Fig. 4)

- (iv) storing the search result set in the data store (Fig. 2, item 134, 112; Fig. 3 items

156, 158; Fig. 12; column 15, lines 35-37, "Proceeding to state... a RAW-RESULT

matrix"; column 10, lines 62-64, "The database 112... are stored therein")

- (v) prioritizing the elements of the search result set (Fig. 3, items 156 to 158 to 162;

Fig. 4, items 210 to 212; Fig. 8, items 314 to 210; Fig. 13B)

Jain et al does not expressly disclose (i) receiving the target mark comprising one or

more mark terms, (1) initializing the search phrase to include the mark terms, (2)

identifying variations for any of the mark terms, wherein the identified variations are of a

type selected from the group consisting of homonyms, translations and common

misspellings, generating a report based upon the search result set or transmitting the

report to an output device.

However, Examiner takes Official Notice that the use of target marks and mark terms for

search phrases and query terms is conventional and well-known. Stated more directly,

trademarks can be used as search terms and have been used as search terms for

some time.

Rivette et al teaches,

- (vi) generating a report based upon the search result set (Fig. 17; Fig. 27, item 2708)

- (vii) transmitting the report to an output device (Fig. 27, item 2706)

Doyle teaches,

- (iv) storing the search result set in the data store (Abstract, sentence 6, "An

application-independent client...the master computer")

Motivation – The portions of the claimed system would have been a highly desirable

feature in this art for

- Verifying consistency of terminology within a document (*Rivette et al,* column 1,

    lines 40-44, "The present invention...verify terminology consistency")

- Increasing productivity while tolerating failures (*Doyle,* column 1, lines 46-56, The

    present invention...as the Internet")

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made, to use marks for searching and modifying *Jain et al* as taught by

Rivette et al and *Doyle* for the purpose of verifying consistency of terminology and

increasing productivity while tolerating failures.

Regarding claim 2:

The rejection of claim 2 is similar to that for claim 1 as recited above since the stated

limitations of the claim are set forth in the references. Claim 2's limitations difference is

taught in *Rivette et al*:

- the one or more storage elements comprises at least one storage element that stores

data on removable media (Fig. 1, item 114)

Regarding claim 3:

Jain et al teaches,

- (a) a data store comprising one or more storage elements (Fig. 1, item 112)

- (b) One or more processors in communication with each other and the data store (Fig. 1, item 102), the one or more processors for:

- (i) receiving one or more phrases, wherein each received phrase comprises one or more terms (Figs. 2, 3)

- (ii) for each received phrase, creating an expanded search phrase by (Figs. 4, 8-10C; column 1, lines 31-42, "An important class ... and so on"):

- (1) initializing the expanded search phrase to include the terms of respective received phrase (Fig. 8, items 370, 372)

- (2) identifying synonyms for any term within the respective received phrase (Fig. 10A, items 406, 408, 432, 434)

- (3) if any synonyms were identified, adding the identified synonyms to the initialized expanded search phrase (Fig. 10A, items 410, 436)

- (iii) generating a search result set by (Figs. 3-4, 8, 10A-C, 12-13B):

- (1) for each expanded search phases, conducting one or more searches in one or more accessible information storage systems based upon the respective expanded search phrase (Fig. 3)

- (2) accumulating results from each of the conducted searches in the search result set (Fig. 4)

- (iv) storing the search result set in the data store (Fig. 2, item 134, 112; Fig. 3 items 156, 158; Fig. 12; column 15, lines 35-37, "Proceeding to state...a RAW-RESULT matrix"; column 10, lines 62-64, "The database 112...are stored therein")

- (v) prioritizing the elements of the search result set (Fig. 3, items 156 to 158 to 162; Fig. 4, items 210 to 212; Fig. 8, items 314 to 210; Fig. 13B)

However, *Jain et al* doesn't explicitly teach each received phrase represents a limitation of the target claim, generating a report based upon the search result set or transmitting the report to an output device while *Rivette et al* teaches,

- (i) receiving one or more phrases, wherein each received phrase represents a limitation of the target claim and comprises one or more terms (Fig. 7, item 708)

- (vi) generating a report based upon the search result set (Fig. 17; Fig. 27, item 2708)

- (vii) transmitting the report to an output device (Fig. 27, item 2706)

Doyle teaches,

- (iv) storing the search result set in the data store (Abstract, sentence 6, "An application-independent client...the master computer")

Motivation – The portions of the claimed system would have been a highly desirable feature in this art for

- Verifying consistency of terminology within a document (*Rivette et al,* column 1, lines 40-44, "The present invention...verify terminology consistency")

- Increasing productivity while tolerating failures (*Doyle,* column 1, lines 46-56, The present invention...as the Internet")

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made, to use marks for searching and modifying *Jain et al* as taught by

Rivette et al and *Doyle* for the purpose of verifying consistency of terminology and

increasing productivity while tolerating failures.

Regarding claim 4:

The rejection of claim 4 is similar to that for claim 3 as recited above since the stated

limitations of the claim are set forth in the references. Claim 4's limitations difference is

taught in *Rivette et al*:

- the one or more storage elements comprises at least one storage element that stores

data on removable media (Fig. 1, item 114)

Regarding claim 7:

Jain et al teaches,

- (a) receiving one or more search phrases associated with the target item, wherein

each received search phrase comprises one or more search terms (Figs. 2, 3)

- (b) for each received phrase, creating an expanded search phrase by (Figs. 4, 8-10C)

- (i) initializing the expanded search phrase to include the search terms of

respective received search phrase (Fig. 8, items 370, 372)

- (ii) identifying variations for any search term within the respective received

phrase (Fig. 10A, items 406, 408, 432, 434)

 - (iii) if any variations were identified, adding the identified variations to the initialized

expanded search phrase (Fig. 10A, items 410, 436)

- (c) generating a search result set by (Figs. 3-4, 8, 10A-C, 12-13B):

- (i) for each expanded search phases, conducting one or more searches in one or more accessible information storage systems based upon the respective expanded search phrase (Fig. 3)

- (ii) accumulating results from each of the conducted searches in the search result set (Fig. 4)

However, *Jain et al* doesn't explicitly teach generating a report based upon the search result set, transmitting the report to an output device or transmitting a request for the document to an information storage system based upon the received reference while *Rivette et al* teaches,

- (i) receiving a document selected from the group consisting of a patent, a patent application, a trademark registration and a trademark registration application (Abstract, sentences 1-3, "A system and...a patent application")

- (ii) extracting the one or more search phrases from the received document (Abstract, sentences 4-6, "The user then...displays these terms")

- (iii) receiving a reference to the document (Fig. 4, item 402)

- (vi) generating a report based upon the search result set (Fig. 17; Fig. 27, item 2708)

- (vii) transmitting the report to an output device (Fig. 27, item 2706)

Doyle teaches,

- (iv) transmitting a request for the document to an information storage system based upon the received reference (Abstract, sentences 5-6, "An application-independent master...the master computer")

Motivation – The portions of the claimed method would have been a highly desirable

feature in this art for

- Verifying consistency of terminology within a document (*Rivette et al,* column 1,

  lines 40-44, "The present invention...verify terminology consistency")

- Increasing productivity while tolerating failures (*Doyle,* column 1, lines 46-56, The

  present invention...as the Internet")

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made, to use marks for searching and modifying *Jain et al* as taught by

Rivette et al and *Doyle* for the purpose of verifying consistency of terminology and

increasing productivity while tolerating failures.

Regarding claim 8:

The rejection of claim 8 is the same as that for claim 1 as recited above since the stated

limitations of the claim are set forth in the references.

Regarding claim 9:

The rejection of claim 9 is similar to that for claim 1 as recited above since the stated

limitations of the claim are set forth in the references. Claim 9's limitations difference is

taught in *Rivette et al*:

- storing the generated report in a data store (Fig. 27, item 2706)

Regarding claim 10:

The rejection of claim 10 is similar to that for claim 1 as recited above since the stated

limitations of the claim are set forth in the references. Claim 10's limitations difference

is taught in *Rivette et al*:

- the generated report comprises one or more fields that upon receipt by the output

device allow a user to edit contents of the one or more fields (Figs. 3-5, 7, 10, 17)

- (f) receiving one or more modifications to the report corresponding to input by the user

into the one or more fields (Fig. 22)

- (g) modifying the report or the search results set based upon the received one or more

modifications (Fig. 27)

Regarding claim 11:

The rejection of claim 11 is the same as that for claim 10 as recited above since the

stated limitations of the claim are set forth in the references.

Regarding claim 12:

The rejection of claim 12 is the same as that for claim 1 as recited above since the

stated limitations of the claim are set forth in the references.

Regarding claim 13:

The rejection of claim 13 is similar to that for claim 12 as recited above since the stated

limitations of the claim are set forth in the references. Claim 13's limitations difference

is taught in *Jain et al*:

- (i) calculating a correspondence value between each element of the search result set

and each of the one or more descriptions (Fig. 9, item 358)

- (ii) sorting the elements of the search result set based upon the calculated

correspondence values (Figs. 13B, 16A, items 766, 772)

Regarding claim 14:

The rejection of claim 14 is similar to that for claim 12 as recited above since the stated

limitations of the claim are set forth in the references. Claim 14's limitations difference

is taught in:

Rivette et al,

- (i) calculating a correspondence value between each element of the search result set

and the technical descriptions (Figs. 7, 10)

Jain et al,

- (ii) sorting the elements of the search result set based upon the calculated

correspondence values (Figs. 13B, 16A, items 766, 772)

Regarding claim 15:

The rejection of claim 15 is similar to that for claim 12 as recited above since the stated

limitations of the claim are set forth in the references. Claim 15's limitations difference

is taught in:

Rivette et al,

- (i) calculating a frequency count associated with each element of the search result set

(Figs. 7, 10)

- sorting document terms (Fig. 25, item 2506)

Jain et al,

- (ii) sorting the elements of the search result set based upon the calculated frequency

count (Figs. 13B, 16A, items 766, 772)

Regarding claim 16-17:

The rejection of claims 16-17 is the same as that for claim 12 as recited above since the

stated limitations of the claims are set forth in the references.

Regarding claim 18:

The rejection of claim 18 is similar to that for claim 1 as recited above since the stated

limitations of the claim are set forth in the references. Claim 18's limitations difference

is taught in *Rivette et al* :

- the target item is a claim (Fig. 7, item 708)

- the receiving step comprises receiving a single search phrase comprising the mark

(Fig. 5, items 512, 516)

Regarding claim 19:

The rejection of claim 19 is the same as that for claim 18 as recited above since the

stated limitations of the claim are set forth in the references.

Regarding claim 20:

The rejection of claim 20 is similar to that for claim 18 as recited above since the stated

limitations of the claim are set forth in the references. Claim 20's limitations difference

is taught in *Jain et al*:

- attempting to create additional expanded search phrases by selectively parsing and

regrouping the one or more search terms of the received single search phrase (Fig. 3,

item 154; Fig. 4, item 204; Fig. 8, item 312, 314, 316, 318, 202;)

Regarding claim 21:

The rejection of claim 21 is similar to that for claim 18 as recited above since the stated

limitations of the claim are set forth in the references. Claim 21's limitations difference

is taught in *Rivette et al*:

- the generated report is selected from the group consisting of a draft registrability

analysis, draft infringement analysis, a draft office action and a table of results (Figs. 5,

10)

Regarding claim 22:

The rejection of claim 22 is similar to that for claim 1 as recited above since the stated

limitations of the claim are set forth in the references. Claim 22's limitations difference

is taught in *Rivette et al*:

- the target item is a claim (Fig. 4, item 406)

- receiving a search phrase corresponding to each limitation of the claim (Fig. 7, item

708)

Regarding claim 23:

The rejection of claim 23 is similar to that for claim 22 as recited above since the stated

limitations of the claim are set forth in the references. Claim 23's limitations difference

is taught in *Jain et al*:

- identifying synonyms (Fig. 10A, items 406, 408, 432, 434)

Regarding claim 24:

The rejection of claim 24 is similar to that for claim 23 as recited above since the stated

limitations of the claim are set forth in the references.   Claim 24's limitations difference

is taught in *Rivette et al*:

- the generated report is selected form the group consisting of a table of results, a draft

patentability analysis, a draft infringement analysis, a draft invalidity analysis, a draft

office action, a draft search report and a draft written opinion (Title, "System, Method,

and...Specification and Claims"; Figs. 5, 10; column 1, lines 14-24, "When drafting

certain ... the patent application")

Regarding claim 25-26:

The rejection of claims 25-26 are the same as that for claim 23 as recited above since

the stated limitations of the claim are set forth in the references.

Regarding claim 27:

Jain et al teaches,

- (a) one or more processors (Fig. 1, item 102)

- (i) selectively receiving one or more search terms (Figs. 2, 3)

- (ii) expanding the one or more search terms to create a search data set (Figs. 4, 8-

10C; column 1, lines 31-42, "An important class ... and so on")

However, *Jain et al* doesn't explicitly teach networked processors or intellectual property

while *Rivette et al* teaches

- (b) an intellectual property search engine resident on the one or more processors, the

intellectual property search engine (Abstract, "A system and ... in the specification"):

- (iii) performing one or more searches of at least one potential intellectual property

reference data set (Fig. 7, items 706, 708)

- (iv) comparing the search data set to the potential intellectual property reference data

set (Fig. 20, item 2012, 2014)

- (v) returning potential intellectual property reference data sets based upon the

comparison between the search data set and the potential intellectual property

reference data set (Fig. 20, items 2016, 2022)

- (a) one or more processors in selective communication with the network (Fig. 1, items

104, 106 and 118; column 4, lines 46-54, "The computer system ... communications

port, etc.")

- (iii) performing one or more searches of at least one potential intellectual property

reference data set (column 6, lines 33-49, "the DDMT 202 commands ... boundary text

phrases")

Doyle et al teaches,

- (iii) performing one or more searches via the network (column 11, lines 26-27,

"Distributed computations can ... or the Internet")

<u>Motivation</u> – The portions of the claimed system would have been a highly desirable

feature in this art for

- • Verifying consistency of terminology within a document (*Rivette et al,* column 1,

  lines 40-44, "The present invention...verify terminology consistency")

- • Increasing productivity while tolerating failures (*Doyle,* column 1, lines 46-56, The

  present invention...as the Internet")

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made, to use marks for searching and modifying *Jain et al* as taught by

Rivette et al and *Doyle* for the purpose of verifying consistency of terminology and

increasing productivity while tolerating failures.

　　　　Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jain*

et al in view of *Rivette et al*.

Regarding claim 5:

Jain et al teaches,

- (a) receiving one or more search phrases associated with the target item, wherein

each received search phrase comprises one or more search terms (Figs. 2, 3)

- (b) for each received phrase, creating an expanded search phrase by (Figs. 4, 8-10C;

column 1, lines 31-42, "An important class ... and so on")

- (i) initializing the expanded search phrase to include the search terms of

respective received search phrase (Fig. 8, items 370, 372)

- (ii) identifying variations for any search term within the respective received

phrase (Fig. 10A, items 406, 408, 432, 434)

 - (iii) if any variations were identified, adding the identified variations to the initialized

expanded search phrase (Fig. 10A, items 410, 436)

- (c) generating a search result set by (Figs. 3-4, 8, 10A-C, 12-13B):

- (i) for each expanded search phases, conducting one or more searches in

one or more accessible information storage systems based upon the respective

expanded search phrase (Fig. 3)

- (ii) accumulating results from each of the conducted searches in the search result set

(Fig. 4)

However, *Jain et al* doesn't explicitly teach generating a report based upon the search

result set or transmitting the report to an output device while *Rivette et al* teaches,

- (vi) generating a report based upon the search result set (Fig. 17; Fig. 27, item 2708)

- (vii) transmitting the report to an output device (Fig. 27, item 2706)

Motivation – The portions of the claimed method would have been a highly desirable

feature in this art for

- Verifying consistency of terminology within a document (*Rivette et al,* column 1,

  lines 40-44, "The present invention...verify terminology consistency")

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made, to use marks for searching and modifying *Jain et al* as taught by

Rivette et al for the purpose of verifying consistency of terminology within a document.

Regarding claim 6:

The rejection of claim 6 is similar to that for claim 5 as recited above since the stated

limitations of the claim are set forth in the references. Claim 6's limitations difference is

taught in *Rivette et al:*

- (i) receiving a document selected from the group consisting of a patent, a patent

application, a trademark registration and a trademark registration application (Abstract,

sentences 1-3, "A system and...a patent application")

- (ii) extracting the one or more search phrases from the received document (Abstract,

sentences 4-6, "The user then...displays these terms")

RESPONSE TO APPLICANTS' AMENDMENT A REMARKS

Applicant(s) argue(s) that several errors have been corrected in the specification,

drawings and amended claims 1, 3, 11 and 23 (Amendment A REMARKS page 9,

paragraph 1).

Information Disclosure Statement

Applicant(s) argue(s) that they have disclosed all available information required

under 37 C.F.R. 1.56 regarding the publication dates of the Lawrence et al, Osborn et al

and Larkey et al references (Amendment A REMARKS page 9, paragraph 2).

The Examiner agrees that the publication dates supplied for the Osborn et al and

Larkey et al references comply with Applicant(s) duty under 37 C.F.R. 1.56. However,

the Examiner requests copies of the Lawrence et al reference and its related IDS due to

missing application papers.

Oath/Declaration

Applicant(s) argue(s) that the new Oath and Declaration 1) state that the persons

making the oath or declaration believe the named inventors to be the original, first and

sole inventors of the subject matter which is claimed and for which a patent is sought

and 2) identifies the provisional application 60/238,566 filed 10/6/00 on which priority is

claimed (Amendment A REMARKS page 9, paragraph 3).

The Examiner agrees that the new Oath and Declaration provide the basis for

removing the objections of the prior office action.

Drawings

Applicant(s) argue(s) that Fig. 1 elements are clearly identified by reference

numerals and are clearly described in the Specification (Amendment A REMARKS page

9, paragraph 4), the process threads in Fig. 2A from step 215 and step 245 are correct

and comply with 37 C.F.R. 1.84 (Amendment A REMARKS page 10, paragraph 1), the

amended Specification correctly recites the process flow from decision 230 in Fig. 2A

(Amendment A REMARKS page 10, paragraph 2) and the Fig. 2C and 2D replacement

sheet corrects errors at steps 325 and 355 (Amendment A REMARKS page 10,

paragraph 3).

The Examiner agrees that the amended Specification and Drawings as well as

the explanations of Fig. 1 and the process threads from steps 215 and 245 of Fig. 2A

remove the grounds for objection in the prior office action.

Specification

Applicant(s) argue(s) that the Specification has been amended to correctly

identify the trademarks and not reference hyperlinks (Amendment A REMARKS page

10, paragraph 4).

The Examiner agrees that the amended Specification removes the grounds for objection in the prior office action.

Claim Objections

Applicant(s) argue(s) that amended claims 1 and 3 correct typographical errors (Amendment A REMARKS page 10, paragraph 5 and page 11, paragraph 1).

The Examiner agrees that amended claims 1 and 3 remove the grounds for objection in the prior office action.

Claim Rejections - 35 USC § 112, 2nd paragraph

Applicant(s) argue(s) that amended claim 11 properly recites a listed element in claim 5 and amended claim 23 depends on claim 22 (Amendment A REMARKS page 11, paragraph 3).

The Examiner agrees that amended claims 11 and 23 overcome the grounds for rejection in the prior office action.

Claim Rejections - 35 USC § 103

Applicant(s) argue(s) that the visual information retrieval system of Jain et al USPN 5,983,237 is not analogous art when searching for target marks and cannot be combined with other references (Amendment A REMARKS page 12, paragraph 2), there is no motivation to combine Jain et al, Rivette et al USPN 5,754,840 and Doyle USPN 6,009,455 (Amendment A REMARKS page 12, paragraph 3) and that all

limitations of claim 1 are not taught or disclosed (Amendment A REMARKS page 12,

paragraph 4 and page 13, paragraph 1).

Applicants' claim 1 arguments are not agreed with as the use of target marks and

mark terms for search phrases and query terms is conventional and well-known.

Furthermore, Jain et al, Rivette et al and Doyle individually and in combination explicitly

and inherently disclose the subject matter set forth in the claims by the applicants:

Jain et al -

- (a) a data store comprising one or more storage elements (Fig. 1, item 112)

- (b) one or more processors in communication with each other and the data store (Fig.

1, item 102), the one or more processors for:

- (i) receiving the query comprising one or more query terms (Figs. 2, 3, 8)

- (ii) creating a search phrase by (Figs. 4, 8-10C)

- (1) initializing the search phrase to include the query terms (Fig. 9, items 370, 372)

- (2) identifying variations for any of the query terms, wherein the identified variations

are of a type selected from the group consisting of homonyms, translations and

common misspellings (Fig. 10A, items 406, 408, 432, 434)

- (3) if any variations were identified, adding the identified variations to the initialized

search phrase (Fig. 10A, items 410, 436)

- (iii) generating a search result set by (Figs. 3-4, 8, 10A-C, 12-13B):

- (1) conducting one or more searches in one or more accessible information storage

systems based upon the created search phrase (Fig. 3)

- (2) accumulating results from each of the conducted searches in the search result set

(Fig. 4)

- (iv) storing the search result set in the data store (Fig. 2, item 134, 112; Fig. 3 items

156, 158; Fig. 12; column 15, lines 35-37, "Proceeding to state... a RAW-RESULT

matrix"; column 10, lines 62-64, "The database 112... are stored therein")

- (v) prioritizing the elements of the search result set (Fig. 3, items 156 to 158 to 162;

Fig. 4, items 210 to 212; Fig. 8, items 314 to 210; Fig. 13B)

Rivette et al -

- (vi) generating a report based upon the search result set (Fig. 17; Fig. 27, item 2708)

- (vii) transmitting the report to an output device (Fig. 27, item 2706)

Doyle -

- (iv) storing the search result set in the data store (Abstract, sentence 6, "An

application-independent client... the master computer")

For the purpose of locating as many relevant references as possible even when

inconsistencies exist in the documents or the network information storage systems, the

motivation for combining the references include 1) maximizing diversity of the results

disclosed in *Jain et al*, column 9, lines 40-43, 2) verifying consistency of terminology

within a document disclosed in *Rivette et al,* column 1, lines 40-44 and 3) increasing

productivity while tolerating failures disclosed in *Doyle,* column 1, lines 46-56.

As set forth above, the use of target marks and mark terms for search phrases

and query terms is conventional and well-known, each element of the applicants' claim

1 limitations are explicitly and inherently taught by Jain et al, Rivette et al and Doyle.

Applicants have not set forth any distinction or offered any dispute between the claims

of the subject application, Jain et al's Visual dictionary, Rivette et al's System, method,

and computer program product for developing and maintaining documents which

includes analyzing a patent application with regards to the specification and claims and

Doyle's Distributed computation utilizing idle networked computers.

Applicant(s) argue(s) that the combination of Jain et al, Rivette et al and Doyle

does not disclose the step of creating an expanded search phrase in claim 3

(Amendment A REMARKS page 14, paragraph 4 and page 15, paragraph 1).

Applicants' claim 3 arguments are not agreed with as Jain et al discloses

synonym terms and equivalent queries in Figs 4, 8-10C and column 1, lines 31-42.

Further, for the purpose of locating as many relevant references as possible even when

inconsistencies exist in the documents or the network information storage systems, the

motivation for combining the references include 1) maximizing diversity of the results

disclosed in *Jain et al*, column 9, lines 40-43, 2) verifying consistency of terminology

within a document disclosed in *Rivette et al,* column 1, lines 40-44 and 3) increasing

productivity while tolerating failures disclosed in *Doyle,* column 1, lines 46-56.

As set forth above, Jain et al, Rivette et al and Doyle explicitly and inherently

teach each element of the applicants' claim 3 limitations. Applicants have not set forth

any distinction or offered any dispute between the claims of the subject application, Jain

et al's Visual dictionary, Rivette et al's System, method, and computer program product

for developing and maintaining documents which includes analyzing a patent

application with regards to the specification and claims and Doyle's Distributed

computation utilizing idle networked computers.

Applicant(s) argue(s) that Jain et al is not analogous art when searching for

target items of intellectual property and cannot be combined with other references

(Amendment A REMARKS page 16, paragraph 3), there is no motivation to combine

Jain et al and Rivette et al (Amendment A REMARKS page 16, paragraph 4) and that

the step of creating an expanded search phrase limitation of claim 5 is not taught or

disclosed (Amendment A REMARKS page 16, paragraph 5 and page 17, paragraph 1).

Applicants' claim 5 arguments are not agreed with as Jain et al and Rivette et al

individually and in combination explicitly and inherently disclose the subject matter set

forth in the claims by the applicants: Rivette et al discloses target items of intellectual

property in the form of a patent application's specification and claims (title, Figs. 4-5, 7,

11, 14, 16) while Jain et al discloses the step of creating an expanded search phrase in

Figs. 4, 8-10C and column 1, lines 31-42. Further, for the purpose of locating as many

relevant references as possible even when inconsistencies exist in the documents, the

motivation for combining the references include 1) maximizing diversity of the results

disclosed in *Jain et al*, column 9, lines 40-43 and 2) verifying consistency of terminology

within a document disclosed in *Rivette et al,* column 1, lines 40-44.

As set forth above, Jain et al and Rivette et al explicitly and inherently teach each

element of the applicants' claim 5 limitations. Applicants have not set forth any

distinction or offered any dispute between the claims of the subject application, Jain et

al's Visual dictionary and Rivette et al's System, method, computer program product for

developing and maintaining documents which includes analyzing a patent application

with regards to the specification.

Applicant(s) argue(s) that the visual information retrieval system of Jain et al is

not analogous art when searching for potential intellectual property references and

cannot be combined with other references (Amendment A REMARKS page 23,

paragraph 2), there is no motivation to combine Jain et al, Rivette et al and Doyle

(Amendment A REMARKS page 23, paragraph 3) and that the step of expanding the

one or more search terms to create a search data set limitation of claim 27 is not taught

or disclosed (Amendment A REMARKS page 12, paragraph 4 and page 13, paragraph

1).

Applicants' claim 27 arguments are not agreed with as Jain et al, Rivette et al

and Doyle individually and in combination explicitly and inherently disclose the subject

matter set forth in the claims by the applicants: Rivette et al discloses target items of

intellectual property in the form of a patent application's specification and claims (title,

Figs. 4-5, 7, 11, 14, 16) while Jain et al discloses the step of expanding the one or more

search terms to create a search data set in Figs. 4, 8-10C and column 1, lines 31-42

and Doyle discloses searching via the network in column 11, lines 26-27. Further, for

the purpose of locating as many relevant references as possible even when

inconsistencies exist in the intellectual property documents or the network data sets, the

motivation for combining the references include 1) maximizing diversity of the results

disclosed in *Jain et al*, column 9, lines 40-43, 2) verifying consistency of terminology

within a document disclosed in *Rivette et al,* column 1, lines 40-44 and 3) increasing

productivity while tolerating failures disclosed in *Doyle,* column 1, lines 46-56.

As set forth above, Jain et al, Rivette et al and Doyle explicitly and inherently

teach each element of the applicants' claim 27 limitations. Applicants have not set forth

any distinction or offered any dispute between the claims of the subject application, Jain

et al's Visual dictionary, Rivette et al's System, method, and computer program product

for developing and maintaining documents which includes analyzing a patent

application with regards to the specification and claims and Doyle's Distributed

computation utilizing idle networked computers.

Applicant(s) argue(s) that remaining claims 2, 4 and 6-26 are patentable over the

cited references with respect to the patentability of claims 1, 3 and 5 (Amendment A

REMARKS page 13, paragraph 3, page 15, paragraph 3, page 17, paragraphs 3-4,

page 18, paragraphs 1-5, page 19, paragraphs 1-4, page 20, paragraphs 1-6, page 21,

paragraphs 1-4 and page 22 paragraphs 1-3) and that the prior art references made of

record are generally indicative of the related art to the present invention (Amendment A

REMARKS page 24, paragraph 3).

In summary, the Examiner agrees that the prior art references made of record

are generally indicative of the related art to the present invention. Consequently for

reasons given in the prior office action and above in the 35 U.S.C. 103(a) patentability

rejection discussions of claims 1, 3 and 5, claims 2, 4 and 6-26 stand rejected under 35

U.S.C. 103(a) for being dependent on rejected independent claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy

as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

 - *Kim et al*; US 5428462 A; Facsimile apparatus having user name register with means

for receiving image signals and for compressing and storing same so as to print

identifier, logo or trademark of sender with reduced storage means

 - *HUANG et al*; US 5999280 A; Holographic anti-imitation patterning device for

preventing unauthorized reproduction of trademark, copyright, logo etc.

 - *Alwis et al*; Searching image databases containing trademarks; IEE Colloquium on

Neural Networks in Interactive Multimedia Systems (Ref. No. 1998/446); 22 Oct. 1998;

pp 2/1-2/5

- *Kim et al*; Content-based trademark retrieval system using visually salient features; Proceedings IEEE Computer Society Conference on Computer Vision and Pattern Recognition; 17-19 June 1997; pp 307-312

- *Ciocca et al*; Similarity retrieval of trademark images; International Conference on Image Analysis and Processing Proceedings; 27-29 Sept. 1999; pp 915-920

- *Leng et al*; A system for trademark pattern registration and recognition; Second International Conference on Knowledge-Based Intelligent Electronic Systems Proceedings; Vol. 3; 21-23 April 1998; pp 363-369

Any inquiry concerning this communication or earlier communications from the Office should be directed to Meltin Bell whose telephone number is 703-305-0362. This Examiner can normally be reached on Mon - Fri 7:30 am - 4:30 pm.

If attempts to reach this Examiner by telephone are unsuccessful, his supervisor, Anthony Knight, can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Anthony Knight
Supervisory Patent Examiner
Group 3600

MB